

## REMARKS

### **A. Claim status**

Claims 10-13 are rejected for the reasons stated below.

### **B. 35 U.S.C. § 112, first paragraph**

Claim 12 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicant maintains that one of ordinary skill in the relevant field would understand that the term material sold by W.L. Gore under the “Gore-Tex” trademark refers to a water-impermeable, water-vapor permeable membrane but nevertheless has canceled claim 12.

### **C. 35 U.S.C. § 103(a)**

Claims 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over international reference WO 92/14372 (“WO ‘372”) in view of U.S. Patent No. 3,805,419 to White (“White”). Applicant traverses this ground for claim rejection for the reasons stated below.

The examiner contends that WO ‘372 discloses all of the limitations of claim 10 except for (1) the insulating material being located but not compressed between the toe box and the lining, and (2) a lining of the cold insulating material having a surface secured to the underside of the toe box. The examiner contends that White teaches an insulating layer 5 for a toe protected boot located, uncompressed, between the toe box 1 and a lining 6. The examiner has argued that it would have been obvious to one of ordinary skill in the art at the time the invention was made to place an insulating layer between the toe box and the liner of WO ‘372 as taught by White to insulate the boot.

WO '372 does not disclose an *oversized* toe box. WO '372 discloses a toe cap "having the shape of a portion of an egg" with the toe cap being "relatively high off the foot at the rear of the toe cap," such that the rear height "not only allows for objects to roll off the foot but enables the foot to bend fully without the upper rubbing against the top of the foot." [WO '372, p. 5, lines 2-7.] Nothing in this description suggests that the toe cap is sized to enclose a substantial thickness of compressible cold insulating material and the corresponding portion of a user's foot without compression of the cold insulating material when in use. White also does not disclose an *oversized* toe box. The shape of the White toe cap (see Figs. 3 and 6) is consistent with the conventional (standard sized) toe boxes shown in Figs. 1 and 2 of the present application.

The absence of any disclosure of an oversized toe box in WO '372 and White is not surprising because both are concerned with foot protecting structures having a layer provided under the toe box for comfort rather than cold insulating. [WO '372, p. 10, line 32 (foam layer 34 is to "provide comfort to the wearer"; White ("cushioning" layer 5 extending below toe cap 6).] Thus, no need exists to provide an oversized toe box sized to enclose a substantial thickness of compressible cold insulating material with either WO '372 or White.

Further, the cushioning function of the foam layer of both WO '372 and White indicates that contact between a user's foot and the foam layer is expected (*e.g.*, because the foam is placed on the underside of a conventional, rather than an oversized, toe box). The expectation that a user's foot will contact the foam layer suggests that compression of the foam layer, and the corresponding loss of thermal insulating capability, is likely. Neither WO '372 nor White teaches or suggests a boot having a toe box sized to enclose a substantial thickness of

compressible cold insulating material and the corresponding portion of a user's foot *without compression of the cold insulating material when the boot is worn.*

Applicant disagrees with the examiner's contention that the cold insulating function of the foam layer of the claimed invention cannot be the basis for patentability because applicant has merely recognized another advantage (function) that flows naturally from the suggestion of the prior art (cushioning). The difference in the function of applicant's foam layer requires a further difference in the size of the toe box which is not taught or suggested in either of the cited references.

For the reasons stated above, the combination of WO '372 and White does not yield the claimed invention. Accordingly, applicant submits that claim 10 is allowable over the cited references. Claim 11 is dependent on claim 10. Applicant submits that this claim also is allowable over the cited references at least for the reasons stated above with respect to claim 10.

Claim 13 is finally rejected under 35 U.S.C. § 103(a) as being unpatentable over WO '372 in view White and U.S. Patent No. 2,814,888 to Hill ("Hill") and further in view of U.S. patent No. 5,689,903 to Aumann ("Aumann"). Applicant also traverses this ground for claim rejection.

As stated above with respect to claim 10, WO '372 and White, taken together, do not teach or suggest all elements of the claimed invention. Neither of these references teaches for suggests an *oversized* toe box as required by claim 13. Hill and Aumann do not teach or suggest this missing element. Accordingly, applicant submits that claim 10 is allowable over the cited references at least for the reasons stated with respect to claim 10.

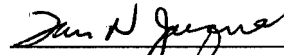
### CONCLUSION

For the reasons stated above, the claims presented herein satisfy the statutory requirements of patentability and are patentable over the cited references. Applicants respectfully submit that the claims are in condition for allowance and request that a Notice of Allowance be issued.

Respectfully submitted,

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